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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,712	08/17/2005	Kuniko Kimura	12480-000108/US	9156
30593 7590 04/15/2009 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 8910 RESTON, VA 20195				
EXAMINER				
ULLAH, ELIAS				
ART UNIT		PAPER NUMBER		
2892				
MAIL DATE		DELIVERY MODE		
04/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,712

Applicant(s)

KIMURA ET AL.

Examiner

ELIAS ULLAH

Art Unit

2892

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-12 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-12 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to an amendment filed on 1/21/2009.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-10, 19-21 are rejected under 35 U.S.C. 102 (b) as being anticipated by Misewich et al. (Misewich, US 2002/0118369 A1).

With regard to claims 1-2, 19-21, Misewich shows method for manufacturing a thin film 12 (Fig. 1), comprising the step of applying a force (Fig. 1 wherein force been applied by field [0018]), with a part having a sharp tip (2 Fig. 2 with respect to Fig. 1), onto an entire area or arbitrary region of a film 12 (Fig. 1) during or after formation of the film 12 a surface of the film is scanned [0022] by using the part having a sharp tip (2, Fig. 2) a mechanical force is applied in a scanning direction [0018 wherein force is applied to AFM tip by voltage that is same applicant disclosed in space page 7 "electric filed and a magnetic force generated by application of a magnetic field").

With the recitation of "so as to control a structure of the film, wherein the structure of the film is controlled by controlling (i) a crystalline structure of crystals constituting the film, (ii) an orientation direction of crystals constituting the film, (iii) an orientation direction of molecules in the crystals, or (iv) any combination of (i) through, so that the crystals and/or molecules are oriented in the scanning direction" is only a

statement of the inherent properties of the product. The product e.g. AFM in recited in Misewich is substantially identical to that of the claims AFM, claimed properties or functions are presumed to be inherent. Or where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977) and MPEP 2112.01.

With regard to claims 3-4, Misewich shows the force applied (see Fig. 1, wherein probe 2 (Fig. 2) is disposed on film 12) on the film 12 derives from only the part having a sharp tip 2 [0018].

With regard to claims 7 and 8, Misewich shows the thin 12 film is formed on a substrate 11.

With regard to claims 9 and 10, Misewich shows the part having a sharp tip is an atomic force microscope [0018].

With regard to claims 17-18, Misewich shows the thin film 12 is made of made of an organic polymer [0018].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misewich et al. (Misewich, US 2002/0118369 A1) in view of Dietzel et al. (Dietzel, US 6,665,258).

With regard to claims 11-12, Misewich teaches plural areas (domains see Fig. 1), but fails to teach plural areas of the film are simultaneously processed with plural parts having sharp tips.

Dietzel teaches plural areas of the film are simultaneously processed with plural parts having sharp tips (col. 5, lines 46-60). At the time the invention was made; it would

have been obvious to a person having ordinary skill in the art to use "plural areas of the film are simultaneously processed with plural parts having sharp tips" teaching of Dietzel in the method for manufacturing a thin film of Misewich, because plural parts having sharp tips are able to measure multiple area of a storage medium as taught by Dietzel in (col. 5, lines 46-50).

Response to Arguments

4. Applicant's arguments filed on 1/21/2009, with respect to the rejection(s) of claims 1-4, 7-12, 17-21 under Foster references have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Misewich et al.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIAS ULLAH whose telephone number is (571)272-1415. The examiner can normally be reached on weekdays, between 8AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thao Le can be reached on (571) 272-1708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elias Ullah/
Examiner, Art Unit 2892

/Lex Malsawma/
Primary Examiner, Art Unit
2892